REMARKS

The Applicants hereby submit this Amendment and Request For Reconsideration in response to the Office Action mailed on 15 June 2007 for the above-identified patent application.

In this amendment, claims 1, 3, 7, 9, 15, and 19, have been amended; no claims have been added or canceled. No new matter has been entered by the amendments made to the claims. The amended limitations are fully supported in the present application as originally filed. The Applicants respectfully request entry of the Amendment and reconsideration of the amended claims of the present application.

In the Office Action of 15 June 2007, the Examiner finally rejected all pending claims of the present application under 35 U.S.C. § 103(a) based on Johannesson et al. (WO 02/069661 A2) and Zhao (U.S. Patent Application Publication US2005/0059397 A1). In response, the Applicants respectfully disagree with the rejections and submit that the claims allowable over the prior art for at least the following reasons.

PERTINENT STANDARDS. In order for claims to be properly rejected under 35 U.S.C. § 103(a), the prior art alone or in combination must teach or suggest each and every limitation of the claims. In addition, there must be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed. When considering various prior art teachings for an obviousness/non-obviousness determination under §103,

> the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter

sought to be patented. *Graham vs. John Deere Co. of Kansas City*, 383 U.S. 1, pp 17-18 (1966).

In this analysis, a functional approach may be taken which asks whether the improvement of the presented invention is more than a predictable use of prior art elements according to their established functions. It is also helpful and instructive to consider whether there is any teaching, suggestion, or motivation to combine the teachings of the references, either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in a flexible and non-rigid manner. The reason or evidence of a motivation to combine teachings need not be found explicitly in the prior art references, as one may also "look to interrelated teachings of multiple patents; the effects of demands know to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, at 1740-41.

REASONS WHY ALL CLAIMS ARE ALLOWABLE. In the present case, there are at least four deficiencies with respect to the Examiner's rejections based on the prior art of record: (1) Johannesson et al. and the remaining prior art of record fail to teach or suggest the step of setting and running a periodic home public land mobile network "HPLMN" timer in response to operating with the communication network having the visiting MCC, as claimed in context; (2) Johannesson et al. and the remaining prior art of record fail to teach or suggest scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating, which is triggered in response to each expiration of the periodic HPLMN timer, as claimed in context; (3) the Examiner's rejection fails to adequately support the teaching or suggestion of the step of receiving, from the step of scanning, a plurality of MNC and MCC pairs associated with the plurality of communication networks; and (4) there is no adequate reasoning or demonstration provided to modify the teachings of Johannesson et al. to obtain the inventive solution as claimed.

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(1) <u>SETTING AND RUNNING A PERIODIC HOME PUBLIC LAND MOBILE NETWORK (HPLMN) TIMER IN RESPONSE TO OPERATING WITH THE COMMUNICATION NETWORK HAVING THE VISITING MCC</u>. The prior art which includes Johannesson et al. fail to teach or suggest "setting and running a periodic home public land mobile network (HPLMN) timer in response to operating with the communication network having the visiting MCC."

Note that the terminology "periodic HPLMN timer" is a term of art of which one ordinarily skilled in the industry would readily appreciate. If the Examiner is not interpreting the terminology "periodic HPLMN timer" as one ordinarily skilled in the art would, the Examiner's interpretation would be <u>unreasonable</u>.

The Examiner argues that Johannesson et al. teach the claimed step of "setting and running the periodic home network timer while operating with the communication network having the visiting MCC" in relation to a passage in Johannesson et al. which states "scan and search for a better PLMN." A closer look at this passage in context reveals the following:

> Within present standards, the mobile station 10 <u>would be</u> required to scan and search for a better PLMN to provide service to the mobile station 10 upon the occurrence of certain criteria such as movement of the mobile station 10 from PLMN 4 to one of the other PLMNs or expiration of the HPLMN timer. In order to improve upon this system, <u>rather than continuously or periodically scanning for a better PLMN 15 to serve the mobile station 10, the PLMN 15 currently serving the mobile station 10 may periodically transmit various information on neighboring PLMNs of the presently serving PLMN</u> as illustrated in FIGURE 2. (Emphasis Added)

See page 4 at lines 4-12 of Johannesson et al. In addition, Johannesson et al. state on page 1 at lines 28-30 that:

> Also, under the present standard the mobile station is required <u>to search for the HPLMN every time the HPLMN timer expires, this can cause an unnecessary drain upon the battery power</u> of the mobile station. (Emphasis Added)

Further, on page 6 at lines 4-12 of Johannesson et al., it is further stated that:

> Thus, rather than periodically scanning for new PLMN based upon the expiration of an HPLMN timer, the scanning will only take place when a better PLMN is determined to be available by logic 32. This conserves a battery power of mobile station 10 since no unnecessary scanning will be done. PLMN reselection will also be done as soon as a better PLMN appears, since the election of a new PLMN will not have to wait upon the expiration of the HPLMN timer which may be anywhere from 6 minutes to 1,536 minutes. Thus, more efficient use of available PLMNs by the mobile station is provided. (Emphasis Added)

The Examiner makes further reference to page 1 of Johannesson et al. for the purported teaching of the periodic HPLMN timer utilized in the method. As illustrated above, however, the teaching of the HPLMN timer on page 1 is not utilized in the described technique of Johannesson et al. The Examiner further argues that Johannesson et al. teaches the claimed timer on page 6 at lines 27-29, which states that "[t]he search could be initiated by a timer (not shown) responsive to a match between the provided MCC and an MCC of a preferred PLMN." However, this "timer" mentioned in Johannesson et al. is not a periodic HPLMN timer. It is not even a periodic timer, as this timer is triggered "responsive to a match between the provided MCC and an MCC of a preferred PLMN." Note further that step 65 (i.e. the scan) and step 75 (i.e. the wait) of FIG. 4 of Johannesson et al. are performed only in response to a match between the MCCs in step 60, but not in response to operating with the communication network having the visiting MCC.

Thus, it is apparent that Johannesson et al. do not teach or suggest the use of a periodic HPLMN timer in the technique in response to operating with the communication network having the visiting MCC as recited in context of the independent claims. In fact, it practically says just the opposite. In accordance with the present invention, the claimed step of scanning is performed "in response to each expiration of the periodic HPLMN timer" which is "set and run" ... "in response to operating with the communication network having the visiting MCC."

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(2) <u>SCANNING TO IDENTIFY A PLURALITY OF COMMUNICATION</u> <u>NETWORKS IN A COVERAGE AREA WITHIN WHICH THE MOBILE STATION IS</u> <u>OPERATING, WHICH IS TRIGGERED IN RESPONSE TO EACH EXPIRATION OF</u> <u>THE PERIODIC HPLMN TIMER WHILE OPERATING WITH THE</u> <u>COMMUNICATION NETWORK HAVING THE VISITING MCC</u>. Johannesson et al. and the prior art of record fail to teach or suggest the step of scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating, which his triggered in response to each expiration of the periodic HPLMN timer while operating with the communication network having the visiting MCC.

The Examiner argues that Johannesson et al. teach the claimed step of "scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating" in relation to a passage in Johannesson et al. which states "scan and search for a better PLMN." However, a closer look at this passage in context reveals the following:

> Within <u>present</u> standards, the mobile station 10 <u>would be</u> required to scan and search for a better PLMN to provide service to the mobile station 10 upon the occurrence of certain criteria such as movement of the mobile station 10 from PLMN 4 to one of the other PLMNs or expiration of the HPLMN timer. In order to improve upon this system, <u>rather than</u> <u>continuously or periodically scanning for a better PLMN 15 to serve the</u> <u>mobile station 10, the PLMN 15 currently serving the mobile station 10</u> <u>may periodically transmit various information on neighboring PLMNs of</u> <u>the presently serving PLMN</u> as illustrated in FIGURE 2. (Emphasis Added)

See page 4 at lines 4-12 of Johannesson et al. In addition, Johannesson et al. state on page 1 at lines 28-30 that:

> Also, under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires, <u>this can cause an</u>

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unnecessary drain upon the battery power of the mobile station. (Emphasis Added)

Further, on page 6 at lines 4-12 of Johannesson et al., it is further stated that:

> Thus, rather than periodically scanning for new PLMN based upon the expiration of an HPLMN timer, the scanning will only take place when a better PLMN is determined to be available by logic 32. This conserves a battery power of mobile station 10 since no unnecessary scanning will be done. PLMN reselection will also be done as soon as a better PLMN appears, since the election of a new PLMN will not have to wait upon the expiration of the HPLMN timer which may be anywhere from 6 minutes to 1,536 minutes. Thus, more efficient use of available PLMNs by the mobile station is provided. (Emphasis Added)

The Examiner makes further reference to page 1 of Johannesson et al. for the purported teaching of the periodic HPLMN timer utilized in the method. As illustrated above, however, the teaching of the HPLMN timer on page 1 is not utilized in the described technique of Johannesson et al. The Examiner further argues that Johannesson et al. teaches the claimed timer on page 6 at lines 27-29, which states that "[t]he search could be initiated by a timer (not shown) responsive to a match between the provided MCC and an MCC of a preferred PLMN." However, this "timer" mentioned in Johannesson et al. is not a periodic HPLMN timer. It is not even a periodic timer, as this timer is triggered "responsive to a match between the provided MCC and an MCC of a preferred PLMN." Note further that step 65 (i.e. the scan) and step 75 (i.e. the wait) of FIG. 4 of Johannesson et al. are performed only in response to a match between the MCCs in step 60, not in response to operating with the communication network having the visiting MCC.

Thus, it is apparent that Johannesson et al. do not teach or suggest the use of periodic HPLMN time-triggered "scanning" step in the technique as recited in context in the independent claims. In fact, it practically says just the opposite. In contrast, in accordance with the present invention, the claimed step of scanning is performed "in response to each expiration of the periodic HPLMN timer" which is "set and run" ... "in response to operating with the communication network having the visiting MCC."

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(3) RECEIVING, FROM THE STEP OF SCANNING, A PLURALITY OF MNC AND MCC PAIRS ASSOCIATED WITH THE PLURALITY OF COMMUNICATION NETWORKS. Johannesson et al. and the prior art do not teach or suggest the step of "receiving, from the step of scanning, a plurality of MNC and MCC pairs associated with the plurality of communication networks" as claimed in context.

The Examiner even admits that Johannesson et al. do not teach or suggest the step of "receiving, from the step of scanning, a plurality of MNC and MCC pairs associated with the plurality of communication networks." To identify such limitations, the Examiner utilizes the Zhao reference. *As asserted in the previous amendment of 19 April 2007, however, the Applicant submits that US2005/0059397A1 does not qualify as prior art for any obviousness rejection under 35 U.S.C. § 103(a). Under 35 U.S.C. § 103(c), such prior art shall not preclude patentability where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The Applicants submitted support for the same in the previous amendment of 19 April 2007.*

(4) NO ADEQUATE REASONING TO MODIFY PRIMARY REFERENCE. There is no adequate reasoning provided for modifying the technique of Johannesson et al. to include use of a "periodic home public land mobile network (HPLMN) timer," the "scanning" step, and the "receiving" step as claimed.

The Applicants respectfully submit that no adequate reasoning is provided because no adequate reasoning exists to do modify the teachings of the references. The prior art must be considered as a whole. Proper consideration must take into account any teachings that *teach away* from the suggested modification of the primary reference. Further, to change the technique of Johannesson et al. in the manner suggested by the Examiner would be to defeat the primary intent and purpose of Johannesson et al's technique. This is clearly apparent from the statements in Johannesson et al., in and of themselves.

In the Office Action, the Examiner attempts to provide a suggestion or motivation by stating that (for example):

> It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Johannesson by incorporating the teachings of Zhao and consequently providing receiving, from the step of scanning, a plurality of mobile network code (MNC) and MCC pairs associated with the plurality of communication networks, motivation being for the purpose of allowing the selection process to compare the list of MNC and MCC pairs and accurately identify the home MCC network. (see e.g. page 5 of the Office Action).

In response, the Applicants submit that the above argument fails to provide an adequate suggestion or motivation to combine the prior art teachings, given the rest of the teachings in Johannesson et al. Again, Johannesson et al. state on page 1 at lines 28-30 that:

> Also, under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires, this can cause an unnecessary drain upon the battery power of the mobile station. (Emphasis Added)

Further, on page 6 at lines 4-12 of Johannesson et al., it is further stated that:

> Thus, rather than periodically scanning for new PLMN based upon the expiration of an HPLMN timer, the scanning will only take place when a better PLMN is determined to be available by logic 32. This conserves a battery power of mobile station 10 since no unnecessary scanning will be done. PLMN reselection will also be done as soon as a better PLMN appears, since the election of a new PLMN will not have to wait upon the expiration of the HPLMN timer which may be anywhere from 6 minutes to 1,536 minutes. Thus, more efficient use of available PLMNs by the mobile station is provided. (Emphasis Added)

As apparent, the Examiner's desire to alter the teachings of Johannesson et al. is improper under 35 U.S.C. § 103(a).

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Thus, the prior art fails to teach or suggest each and every limitation in the claimed steps as revised, and there is no adequate reasoning or demonstration for modifying the teachings of Johannesson et al. as the Examiner intends. Therefore, the Applicants respectfully request the Examiner to withdraw the §103 rejections, and allow the claims as amended.

Based on the above, the Applicants respectfully submit that the claims as amended are allowable over the prior art of record and the application is now in a condition suitable for allowance.

Thank you. Please feel free to contact the undersigned if it would expedite prosecution of the application.

Respectfully Submitted,

/John J. Oskorep/

Date: 03 October 2007

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